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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/296,864 02/17/98 SCHOEN

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QM12/0202

EXAMINER

PARADISO, J

ART UNIT

PAPER NUMBER

3713

DATE MAILED:

02/02/00

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/296,864

Applicant(s)

SCHOEN

Examiner

John Paradiso

Group Art Unit

3713



☒ Responsive to communication(s) filed on 2/17/98

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-5 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-5 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### Specification

- ✕ 1. The Specification does not contain a brief description of Figures 5 or 6. A reference to and brief description of the drawing(s) must be included as set forth in 37 CFR 1.74.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

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X 3. The specification is objected to under 37 CFR 1.71 because it fails to provide an adequate written disclosure of how to modify a metrorail farecard selection system to provide a lottery feature. The disclosure presented merely suggests that such a modification can be done, but not how..

4. If applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

*Claim Rejections - 35 USC § 112, 1st Paragraph*

X 5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention for the reasons set forth in paragraph 3 above.

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Claim Rejections - 35 USC § 112, 2nd Paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ Claim 1 line 1 recites "a technique for...". However, claims 2-5 all recite "A system according to claim 1...".

*changed*

✓ Claim 1 lines 1-2 recite "the capability to supplement mass transit services...by addition of electronic lottery processes and operations.." but it is unclear what is meant by "the capability".

*old version deleted*

✓ In claim 1 line 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

*used "Selected from" language*

✓ Claim 1 lines 6-8 recite means for electronically identifying and redeeming customer invoicing media...to provide predetermined payouts" but claim 1 lines 9-10 recite "software means to select winning customers and the amount of money to be awarded". It is unclear how the payouts can be predetermined and selected by the software means, too.

*deleted*

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✓ In claim 3 line 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

*deleted  
"such as"*

✓ In claim 4 line 1, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

*deleted  
"such as"*

✓ Claim 4 lines 1-3 recite "wherein an Internet system...is modified with said means" but it is unclear as to the scope and method of said modification.

*deleted  
previously*

✓ Claim 5 lines 1-2 recite "wherein parking lots, ... modify their ticket systems using said means" but it is unclear as to the scope and method of said modification.

*deleted*

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*Claim Rejections - 35 USC § 102*

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9. Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by ROSSIDES.

ROSSIDES discloses a technique for modifying various purchase systems with electronic lottery processes and operations. ROSSIDES discloses the addition of electronically identifying and redeeming customer invoicing media, such as farecards (in metro farecard machines), movie tickets, cash registers or credit card bills, parking lots, and sporting events to provide lottery play and payouts, including software to select winning combinations and security means to secure the integrity of the selections. (See ROSSIDES columns 1-6 and 44-46 and figures 10 and 13-16.)

Regarding claim 4, Examiner notes that the claim is being read as the "corporation with a large Internet marketing service" being modified.

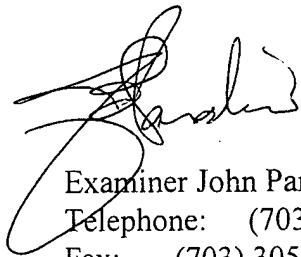
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Conclusion

10. The following prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

- GOLIGHTLY discloses a point of sale lottery system for use at cash registers.
- GOUSSIOS discloses a dual-purpose lottery ticket and boarding pass for commercial travel.
- BERGERON discloses an online wagering system with programmable game entry cards.
- GOLDMAN ET AL discloses a method of securing lottery tickets.
- MULLER ET AL discloses a secure lottery ticket.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to:



Examiner John Paradiso  
Telephone: (703) 308-2825  
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January 28, 2000